

6173/20US

REMARKS

Claims 1-13, 15-30 and 32-39 are now pending in this application. Claim 40 has cancelled by this Amendment.

The Office Action September 8, 2003 objected to claim 40 as being of improper dependent form. The Office Action rejected claims 1-7, 32-35 and 37-40 as being anticipated under 35 U.S.C. 102(b) by U.S. Patent No. 5,313,653 to Sasuta; and rejected claims 1, 8, 9, 18, 19, 21, 23-26, 37 and 38 as being anticipated under 35 U.S.C. 102(a) by Rosenberg "SIP and Instant Messaging"). The Office Action also rejected claims 10-13 and 15-17 as being obvious over Donovan ("IMPS - Instant Messaging and Presence Using SIP") in view of Holmes-Kinsella (U.S. Patent Application Publication No. 2002/0147000), and rejected claims 27-30 as being obvious over Rosenberg in view of Holmes-Kinsella (U.S. Patent Application Publication No. 2002/0147000). Applicant gratefully acknowledges the indication that claims 20, 22 and 36 are allowable.

Claim Objection

The objection to claim 40 is set forth in part 3 on page 3 of the Office Action. Claim 40 is objected to as being improperly dependent for failing to further limit the subject matter of claim 32 on which it depends. Claim 40 has been cancelled by this Amendment. Therefore, the objection to claim 40 has been rendered moot.

6173/20US

Anticipation Rejection - Sasuta

The grounds for the anticipation rejection of claims 1-7, 32-35 and 37-40 as being anticipated under 35 U.S.C. 102(b) by U.S. Patent No. 5,313,653 to Sasuta is repeated in part 5 on pages 3-6 of the Office Action. A response to applicant's previous arguments against this rejection is set forth in part 1 on page 2 of the Office Action. Applicant respectfully traverses the rejection at least because it does not establish a prima facie case that Sasuta includes each and every one of the combination of features recited in independent claims 1 and 32.

For example, claim 1 is directed to a mobility and service recovery method for a user in a wireless communication network that includes a subscription message "containing a unique indication of a particular user". Claim 32 is directed to a mobile terminal and recites substantially the same feature.

The response to applicant's arguments in the outstanding Office Action mistakenly states that Sasuta inherently includes this feature. It states that "examiner is unaware of any way that the communication resource allocator could identify which communication unit entry to search for other than by receiving an identification of the communication unit in the subscription message."¹ Whether inherently or otherwise, applicant does not dispute that Sasuta contains an identification of the communication unit. However, this does not anticipate the claims because identification of a communication unit is different than the identification of the user of a communication unit. This is made clear in the original filed specification, which explains that it is possible to provide identity of a particular user using a device such as a SIM card (see paragraphs 0003 and 0026). This user identification allows the user to use different mobile

¹ The response also refers in passing to U.S. Patent No. 5,440,758 to Grube et al. If it intended to rely upon this patent as a reference, it should be properly cited and a copy provided.

6173/20US

terminals, but this in turn presents other problems that can be solved by the preferred embodiment of the invention (see paragraphs 0007 to 0009).

Indeed, completely understood, it appears that Sasuta actually teaches away from the claimed invention. The preferred embodiments of the inventions in claims 1 and 32 are directed to systems involving user identification at different terminals. In contrast, Sasuta is concerned with identification of the communication unit, and does not address identification of the particular user, much less the problems identified by the inventor. There is thus no disclosure or suggestion of the method of claim 1 or the mobile terminal of claim 32 in Sasuta.

Anticipation Rejection - Rosenberg

The grounds for the anticipation rejection of claims 1, 8, 9, 18, 19, 21, 23-26, 37 and 38 as being anticipated under 35 U.S.C. 102(a) by Rosenberg "SIP and Instant Messaging") is repeated in part 10 on pages 7-8 of the Office Action. A response to applicant's previous arguments against this rejection is set forth in part 1 on page 2-3 of the Office Action. Applicant respectfully traverses the rejection at least because it does not establish a prima facie case that Sasuta includes each and every one of the combination of features recited in independent claim 1.

For example, in addition to the feature discussed above, claim 1 also recites "returning a notification message to the user terminal, the payload of said notification message including service information for the user to be used by the user terminal for communication services." Even if Rosenberg does adequately disclose the feature of an indication by a particular user, it does not disclose this additional feature.

The response to applicant's arguments states, without citing any reference in support, that it is "well known" that the From and To headers in SIP subscribe messages indicate a particular

6173/20US

user. As noted previously, applicant stated in the originally filed specification that devices, such as SIM cards, are known that provide identification of a particular user no matter what terminal the user is currently using, rather than an identification of a terminal device that may be associated with a user. However, it is not clear that Rosenberg uses the From or To header to indicate a particular user no matter what device the user is using rather than a terminal device that is associated with the user. The generic issue of whether or not it is "well known" that the From and To headers in a SIP Subscribe message indicate a particular user² is not relevant to the outstanding rejection based on Rosenberg, in which the only relevant issue is whether Rosenberg discloses using the From and To headers in the SIP Subscribe message to indicate a particular user. The rejection fails to establish a prima facie case that Rosenberg uses the From and To headers in the SIP Subscribe message to indicate a particular user.

Furthermore, the rejection relies upon the presence data in Rosenberg as anticipating the "service information" recited in the rejected claims. However, the presence data in Rosenberg is not the same as the service information recited in the claims. As described in the originally filed specification, such as in paragraphs 0007-0009, 0026 and 0027, service information is that information which is utilized to allow the user to continue their communication services at a new or recovered terminal. The presence data of Rosenberg is data that is related to presence-based communication services, but it is not the service information that is recited in the claims. Original claim 10 also demonstrates that there is a distinction between presence data and service information, since it separately recites both "information indicating the presence, status and/or location" and "service information" within the claim.

² Applicant challenges this assertion, noting that the SIP protocol was only recently promulgated by the IETF (RFC 3261) when this application was filed.

6173/20US

Obviousness Rejections

The grounds for the obviousness rejection of claims 10-13, 15-17 and 27-30 as being obvious over Donovan ("IMPS - Instant Messaging and Presence Using SIP") or Rosenberg in view of Holmes-Kinsella (U.S. Patent Application Publication No. 2002/0147000) is set forth on pages 9-13 of the Office Action. Applicant respectfully submits that the obviousness rejection fails to establish a prima facie case that the proposed combination of cited references suggest each and every one of the features recited in the rejected claims.

The patent to Holmes-Kinsella is directed to associated devices to a user's account and allows a user to designate an additional device to receive subscribed services so that there may be multiple devices authorized for a customer account. As noted above with respect to Sasuta, this is fundamentally different than the claimed invention because it operates on the premise of identifying terminals rather than having service information be provided upon identification of a user using the device. Holmes-Kinsella thus directly teaches away from the claimed invention. It suggests that a user should be enabled to utilize multiple devices by having device identifiers added to a subscriber account. It also requires action to be taken by the user in adding the device to the account whereas in the claimed invention the subscribe message enables the user to use a recovered or different terminal without taking such action.

The rejection does not comment on this fundamental aspect of Holmes-Kinsella and it appears to utilize only a limited part of Holmes-Kinsella in making the obviousness rejections. However, there is no reason that one of ordinary skill in the art would attempt to modify either of Donovan or Rosenberg according to Holmes-Kinsella in the limited manner proposed in the rejection were it not for the hindsight provided by this application in attempting to meet all of the limitations of the claims. One of ordinary skill in the art would conclude from Holmes-Kinsella

6173/20US

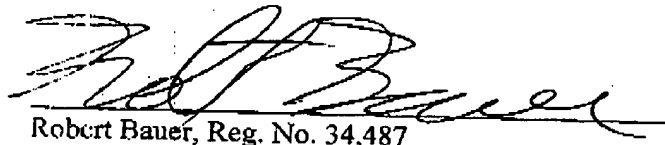
that a user should be enabled to use different terminals by adding device identifiers to the user's account, rather than by the method recited in the claims.

Conclusion

Applicant respectfully submits that the rejections fail to establish that the claims are anticipated or rendered obvious by the prior art. It is respectfully requested that each one of pending claims 1-13, 15-30 and 32-39 be allowed and a formal Notice of Allowance be promptly mailed.

Please charge any fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 02-4270 (6173/20US) and please credit any excess fees to such deposit account.

Respectfully Submitted,



Robert Bauer, Reg. No. 34,487
BROWN RAYSMAN MILLSTEIN FELDER &
STEINER LLP
900 Third Avenue
New York, NY 10022
Tel: (212) 895-2000
Fax: (212) 895-2600